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PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2173**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ruth E. ROSENHOLT et al.

Group Art Unit: 2173

Application No.: 09/682,230

Examiner: T. Zhou

Filed: August 8, 2001

Docket No.: 110269

For: **METHOD AND SYSTEMS FOR DOCUMENT NAVIGATION USING ENHANCED THUMBNAILS**

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the July 8, 2004 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Currently, claims 1-22 and 26-28 are pending.

A. Applicants thank Examiner Zhou for the courtesies extended to Applicants' representatives during the August 19 personal interview. During the interview, Applicants' representatives explained the claim language and the distinctions from the applied art.

B. The Office Action rejects claims 1-4, 7-8, 12-15, 18-19, and 26-27 under 35 U.S.C. §102(b) over U.S. Patent No. 5,751,287 to Hahn et al. (Hahn). This rejection is respectfully traversed.

Claim 1 recites, *inter alia*, a thumbnail has at least one first selectable element, that the thumbnail as a whole is selectable and having an original document as a first associated destination, and that the first selectable element has, as a second associated destination, one of (a) a portion of the original document smaller than the original document as a whole and (b) a document other than the original document. An example is described at paragraph [0053] of the specification, for example. In other words, the thumbnail itself is selectable to display an original document, while it separately has a selectable element therein that enables selection of another document or portion. The Office Action asserts that Hahn teaches these features. Applicants respectfully disagree.

As discussed during the interview, the Office Action cites col. 12, lines 8-12 for the teaching of the feature that a thumbnail as a whole is selectable and has an original document as a first associated destination. However, this embodiment merely states that a selected page from a thumbnail is displayed in a document view region. Col. 12, lines 12-24 describe that in order for the original document to be displayed, one of the function buttons must be selected, although this section teaches that a user can directly select a portion of a thumbnail page and, in response, the selected portion is displayed. Therefore, this section does not teach or suggest that the thumbnail as a whole is selectable and having an original document as a first associated destination.

The Office Action also refers to col. 11, lines 33-56 in asserting that a page of a document associated with a thumbnail view is displayed by selecting the thumbnail view. However, it is also described in this embodiment that, to display different parts of the document, vertical scroll bars are manipulated. In other words, the thumbnail in this embodiment does not have a selectable element that directs to a second associated destination. Rather, some structure located other than on the thumbnail is required for selection.

In addition, the Office Action alleges that Hahn teaches that a document other than the original document can be directly accessed, by stating "other pages of the document can be selected and displayed by the user" (emphasis added). Applicants respectfully submit that "other pages" of the document are not a different document as recited. Therefore, this section does not teach or suggest that the first selectable element has, as a second associated destination, one of (a) a portion of the original document smaller than the original document as a whole and (b) a document other than the original document.

Therefore, Applicants respectfully submit that none of the embodiments disclosed by Hahn teach or suggest that a thumbnail has a first selectable element, that the thumbnail as a whole is selectable and having an original document as a first associated destination, and that the first selectable element has, as a second associated destination, one of (a) a portion of the original document smaller than the original document as a whole and (b) a document other than the original document. That is, the thumbnail itself can be selected to display both the original document (by selecting a portion other than at the first selectable element) and another document (by selection of the first selectable element on the thumbnail).

During the interview, Examiner Zhou suggested the possibility of combining these two embodiments. However, as discussed during the interview, there would have been no motivation for one having ordinary skill in the art to have combined the two embodiments because one is not compatible with the other and thus teaches away (see MPEP 2143.01). That is, both allow selection of only one of the two displays using the thumbnail and require structure other than the thumbnail (such as a remote function button) to achieve both displays. There is no discussion of how both embodiments could be combined in an operable manner because both rely on the thumbnail for non-compatible purposes.

At least for this reason, Applicants respectfully submit that claim 1 is patentably distinct from the applied prior art.

Claims 2 and 3 are allowable at least for their dependence on allowable claim 1, as well as for the additional features they recite.

Claim 4 recites, *inter alia*, that a thumbnail has a first selectable element, that the first selectable element has, as an associated destination, one of (a) an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document and (b) a document other than the original document, and that the associated destination is directly accessed based on a selection of the first selectable element. This feature is described in the specification at, for example, paragraph [0045]. In other words, as explained by Applicants' representatives, if an original document has a selectable element (e.g., a hyperlink) that is associated to another document or another portion of the original document, and if the thumbnail of the original document has such a selectable element also, a user can select the selectable element in the thumbnail, so that a destination of the selectable element (e.g., the destination of the hyperlink) can be assessed directly without first retrieving the original document.

Hahn teaches that a section in the original document can be directly accessed. However, this directly-accessed section is merely a section that corresponds to the selected section in a thumbnail. See col. 12, lines 24-29. That is not an arbitrary position accessible by a second selectable element in the original document. Therefore, in Hahn, the user has to retrieve the selectable element in the original document by selecting the corresponding section in the thumbnail, and then select the selectable element in the original document to access the arbitrary destination.

In addition, similar to the above, the Office Action alleges that Hahn teaches that a document other than the original document can be directly accessed, by stating "any other page of the document can be selected and displayed by the user" (emphasis added). Applicants respectfully submit that "any other page" of the document is not a different

document. Thus, in Hahn, the user cannot directly access any other page of the document, without first selecting a thumbnail associated with that page of the document. Therefore, Hahn does not teach or suggest that one of (a) an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document and (b) a document other than the original document is directly accessed based on a selection of the first selectable element.

At least for this reason, Applicants respectfully submit that claim 4 is patentably distinct from the applied art.

Claims 7 and 8 are allowable at least for their dependence on allowable claim 4, as well as the additional features they recite.

Claim 12 recites features similar to claim 1. As such, claim 12 is patentably distinct from the applied art.

Claims 13 and 14 are allowable at least for their dependence on allowable claim 12, as well as for the additional features they recite.

Claim 15 recites the features similar to claim 4. As such, claim 15 is patentably distinct from the applied prior art.

Claims 18 and 19 are allowable at least for their dependence on allowable claim 15, as well as for the additional features they recite.

Claims 26 and 27 recites the features similar to claims 1 and 4, respectively. As such, Claims 26 and 27 are patentably distinct from the applied prior art.

At least for these reasons, Applicants respectfully request withdrawal of this rejection.

C. The Office Action rejects claims 9-11, 20-22 and 28 under 35 U.S.C. §103(a) over Hahn in view of U.S. Patent No. 6,405,192 to Brown et al. (Brown). This rejection is respectfully traversed.

Claim 9 recites, *inter alia*, that an enhanced thumbnail has at least one element with a modified appearance relative to an appearance of a corresponding element in the original document. This feature is shown in Fig. 5, for example.

The Office Action admits that Hahn does not teach or suggest this feature but asserts that Brown does. The Office Action states that Brown modifies the appearances of thumbnails by placing a dark border around the thumbnails that contains matches to the user's undesirable criteria and adds a "Do Not Enter" icon indicating to the user that the linked page contains undesirable features, or displays the thumbnail with different colors.

However, as discussed during the interview, Brown does not teach or suggest an enhanced thumbnail that has an element with a modified appearance relative to an appearance of a corresponding element in the original document. In other words, in Brown, if the user's undesirable criteria is matched, the appearance of the whole thumbnail changes (such as a border), or the modified appearance that is not relative to an appearance of a corresponding element in the original document is applied (e.g., "Do Not Enter" icon). Thus, Brown does not teach or suggest this claimed feature of an enhanced thumbnail with an element corresponding to an original element that has a modified appearance, such as, for example, the RECIPE in Applicants' drawings. Accordingly, claim 9 is patentably distinct from the applied art.

Claims 10 and 11 are allowable at least for their dependence on claim 9, as well as for the additional features they recite. For example, claim 10 recites that the element with a modified appearance is the first selectable element. The Office Action asserts that Brown teaches that a thumbnail with a modified appearance is linked to a page from the search results that the user can select from. Applicants respectfully submit that in Brown, the modification is applied to the thumbnail as a whole because the modified appearance indicates that the linked page "contains" undesirable features to the user. Therefore, the

modified appearance only applies to the thumbnail as a whole. Accordingly, the element with a modified appearance taught by Brown is not the first selectable element.

Claim 20 and 28 recite features similar to claim 9. As such, claims 20 and 28 are patently distinct from the applied art.

Claims 21-22 are allowable at least for their dependence on allowable base claim 20, as well as the additional features they recite.

D. The Office Action rejects claims 5-6 and 16-17 under 35 U.S.C. §103(a) over Hahn in view of Brown. This rejection is respectfully traversed.

Claims 5-6 and 16-17 are allowable at least for their dependence on allowable base claims, as well as for the features they recite.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 and 26-28 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Stephen P. Catlin
Registration No. 36,101

JAO:KXH/aaw

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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